

REMARKS

The present application was filed on June 29, 2000, with claims 1-8, as a continuation of U.S. Patent Application Serial No. 08/864,403 filed May 28, 1997. Claims 1-8 remain pending in the present application. Claims 1 and 5 are the independent claims.

Claims 1-3 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,382,974 (hereinafter "Soeda"), U.S. Patent No. 6,519,000 (hereinafter "Udagawa") and U.S. Patent No. 5,486,611 (hereinafter "Astle").

Claim 4 is rejected under §103(a) as being unpatentable over Soeda, Udagawa and Astle in view of U.S. Patent No. 5,157,511 (hereinafter "Kawai").

Claims 6-8 are rejected under §103(a) as being unpatentable over Soeda, Udagawa and Astle in view of U.S. Patent No. 5,754,227 (hereinafter "Fukuoka").

In this response, Applicant traverses the §103(a) rejections. Applicant respectfully requests reconsideration of the present application in view of the remarks below.

A proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicant submits that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejections of claims 1 to 8, in that the proposed combinations of references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method for recording a multimedia presentation. The method includes the steps of:

- a) capturing a motion image of a scene with a digital video camera adapted to record both motion and higher resolution still images, the higher resolution still images having at least four times the resolution of the motion images;
- b) compressing the motion image and storing the compressed motion image in the digital video camera;
- c) periodically during the capture of the motion image, capturing a higher resolution still image of the scene;
- d) storing the still image in the digital video camera; and
- e) creating and storing a link in the digital video camera between the still image and a corresponding frame in the compressed motion image at the time that the still image is captured.

Thus, the present invention as set forth in claim 1 requires a particular relationship between still image resolution and motion image resolution, namely, that the still image resolution be at least four times the motion image resolution. Moreover, the claim requires storage, in a digital video camera, of a compressed motion image, a still image captured during capture of the motion image, and a link between the still image and a corresponding frame in the compressed motion image. It is important to note that the still image is not itself a frame of the compressed motion image. This is apparent from the fact that the claim calls for storage of a link between the still image and a corresponding frame in the compressed motion image, thereby indicating that the still image and the corresponding motion image frame are separate and distinct elements.

The Examiner argues that all limitations of claim 1 are met by the proposed combination of Soeda, Udagawa and Astle. Applicant respectfully disagrees.

With regard to the limitation of claim 1 requiring that the still image resolution be at least four times the motion image resolution, the Examiner relies on the teachings in Udagawa at column 5, lines 49 et seq. and column 8, lines 10 et seq. However, the relied-upon portions of Udagawa fail to teach or suggest the particular limitation in question, in that there is no mention of still image resolution being at least four times the motion image resolution. To the contrary, it appears to be suggested in Udagawa, from column 6, lines 50-51, column 7, lines 16-22, 28-29 and 58-65, that

both the still image mode and the normal movie mode utilize the full array of 307200 pixels as shown in FIG. 2, and thus have substantially the same resolution. In any case, there is no mention whatsoever in Udagawa regarding the still image resolution being at least four times the motion image resolution. The other references fail to supplement this deficiency of Udagawa. For example, Soeda fails to disclose any difference in the respective resolutions of the still and motion images disclosed therein. The collective teachings of Soeda, Udagawa and Astle simply fail to meet this explicit limitation of claim 1.

Similarly, the collective teachings of these references fail to meet the claim limitations relating to storage, in a digital video camera, of a compressed motion image, a still image captured during capture of the motion image, and a link between the still image and a corresponding frame in the compressed motion image. The Examiner relies primarily on Soeda and Astle for these limitations. However, their collective teachings fail to meet the limitations in question, and in fact teach away from them. For example, Soeda in column 15, lines 26-35, teaches to use an index signal to facilitate retrieval of a still image from a motion image, as follows:

Upon the still photography, the still controller 68 supplies an index signal (not shown) indicative of the still photography to the image recording unit 59 in such a manner as to be recorded on a video tape. Thus, a desired motionless picture or still can quickly and easily be retrieved from a movie, i.e., motion pictures upon reproduction on the basis of the input index signal, for thereby making it possible to visually confirm the still as a hard copy in a short period of time.

As indicated above, this appears to suggest an arrangement in which an index signal is used to facilitate retrieval of a still image from a motion image, and as such constitutes a direct teaching away from the claimed arrangement in which a still image and a corresponding frame of a motion image are separate and distinct elements. The Astle reference fails to supplement this fundamental deficiency of Soeda, in that the index

frames referred to in Astle are apparently actual frames of a motion video sequence. See column 6, lines 4-9, of Astle, which provides as follows, with emphasis supplied:

Index frames are selected in the current invention from the plurality of video frames constituting a video database based on the amount of change in scenes depicted in the video database, so that significantly different scenes, images, or video shots within the video database are represented by an index frame. Thus, each index frame represents a unique scene corresponding to a particular sequence of video frames, or "video sequence." As will be understood by those skilled in the art, an index frame is "representative" of its corresponding video sequence in that a user can recognize the represented video sequence by viewing the index frame. Thus, if the user is familiar with the particular scene represented, he may be reminded of the scene when he sees the index frame. If the user has forgotten or is unfamiliar with the scene, the user can get some idea of the visual contents of the images and features in the represented video sequence when he sees the corresponding index frame.

It is therefore apparent that Astle discloses using an actual frame of a given video sequence as an index to that sequence. This is in contrast to the claimed invention, in which the stored link is between the still image and a corresponding frame in the compressed motion image, thereby indicating that the still image and the corresponding motion image frame are separate and distinct elements.

Accordingly, it is believed that the combined teachings of Soeda, Udagawa and Astle fail to meet the limitations of claim 1 relating to the still image resolution being at least four times the motion image resolution, and the storage of a link between a still image and a corresponding frame in a compressed motion image.

Inasmuch as claim 1 includes limitations not taught or suggested by the combined teachings of Soeda, Udagawa and Astle, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the Soeda, Udagawa and Astle references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine or to modify the Soeda, Udagawa and Astle references to produce the particular limitations in question.

More specifically, the Examiner states in the Office Action at the bottom of page 3 and the top of page 4 that one would be motivated to make the proposed combination because it “would allow fast retrieval of motion images.” Applicant submits that this statement is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. Also, as indicated previously, the cited references each include disclosure that teaches away from the claim limitations, in the manner outlined above.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 over Soeda, Udagawa and Astle has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicant.

The §103(a) rejection of claim 1 over the proposed combination of Soeda, Udagawa and Astle is believed to be improper, and should be withdrawn.

Dependent claims 2, 3 and 4 are believed allowable for at least the reasons identified above with regard to independent claim 1. With regard to claim 4, the Kawai reference cited by the Examiner fails to supplemental the fundamental deficiencies of the proposed combination of references as applied to the independent

claim. In addition, the Examiner provides only conclusory statements of motivation for combining Soeda, Udagawa and Astle with Kawai, and thus fails to establish a proper *prima facie* case for this additional combination. See the bottom of page 5 of the Office Action.

Independent claim 5 includes limitations similar to those of claim 1, and is believed allowable over the proposed combination of Soeda, Udagawa and Astle for reasons similar to those identified above with regard to claim 1. For example, claim 5 calls for a still image signal having a resolution at least four times that of a video signal, and recites a pointer linking a captured still image with a corresponding frame in a compressed video bit stream. Such limitations are not disclosed or suggested by the proposed combination of Soeda, Udagawa and Astle.

Dependent claims 6-8 are believed allowable at least by virtue of their dependence from claim 5. The Fukuoka reference cited by the Examiner fails to supplemental the fundamental deficiencies of the proposed combination of references as applied to the independent claim. In addition, the Examiner provides only conclusory statements of motivation for combining Soeda, Udagawa and Astle with Fukuoka, and thus fails to establish a proper *prima facie* case for this additional combination. See the bottom of page 7 of the Office Action.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,



Pamela R. Crocker
Attorney for Applicant(s)
Registration No. 42,447

PRC:cjm
Telephone: (585) 477-0553
Facsimile: (585) 477-4646